Docket No.: 8733.561.00-US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Hong Suk Yoo et al.

Application No.: 10/026,477

Filed: December 27, 2001

For: LIQUID CRYSTAL DISPLAY DEVICE AND METHOD FOR MANUFACTURING THE SAME

Confirmation No.: 7762

Art Unit: 2871

Examiner: Timothy L. Rude

Customer No.: 30827

REQUEST FOR RECONSIDERATION

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action dated July 13, 2004, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 15-25 in view of the remarks presented herein below.

In the Advisory Action (Paper No. 20041204) mailed December 14, 2004, the Examiner asserts that Applicants' arguments presented in the Request for Reconsideration are not persuasive. More specifically, the Examiner asserts that "Applicant argues against certain latitudes in restriction practice." This assertion is unfounded for the following reasons.

Applicants have not argued against "latitudes" in restriction practice. To the contrary, Applicants argue against the Examiner's use of restriction practice to support a rejection under 35 U.S.C. §103(a) (See discussion below). While the Examiner's comments regarding restriction practice may be correct with regard to restricting claims in an application, they are not

correctly applied to a rejection under 35 U.S.C. §103(a). The Examiner appears to assert that if the present invention also claimed the subject matter of the Moon patent, the claims to the subject matter of the Moon patent and the present claims would be restricted as being obvious species of each other. However, this is NOT the case in the present application. As noted by the Examiner in the Action, Moon fails to disclose each and every claimed element, specifically a first insulating layer formed on an entire surface of the first substrate except an upper portion of the storage capacitor electrode. Accordingly, absent proper motivation to modify the teaching of Moon to include the missing element, the Examiner's rejection is improper (see discussion below).

Furthermore, the Examiner asserts that the previous arguments have been fully considered, however, the Examiner only addresses a sub-set of Applicants' previous arguments. Accordingly, Applicants' respectfully request that the Examiner consider each and every argument presented by Applicants.

In paragraph 4 of the Office Action, the Examiner rejects claims 15-22 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,133,967 to Moon ("Moon"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. §103, the Office Action must set forth a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some motivation or suggestion to modified the applied reference. Second there must be a reasonable expectation of success. Finally, the reference must teach each and every claimed element. (See MPEP §2143) In the present case, claims 15-22 are not properly rejected under 35 U.S.C. §103 because the Office Action fails to establish a *prima facie* case of obviousness.

In rejecting independent claim 15, from which claims 16-22 variously depend, the Examiner asserts that although Moon fails to disclose a first insulating layer formed on an entire surface of the first substrate except an upper portion of the storage capacitor electrode, it would have been obvious to one skilled in the art to modify the LCD of Moon such that the insulating gate layer 5 is removed only from the capacitor electrode to facilitate formation of a capacitor with increased capacity. To support this conclusion, the Examiner makes varies assertions, each of which are unfounded as discussed below.

First, the Examiner asserts that the teachings of Moon render the claimed invention obvious since there is no disclosed functional significance to the structural difference between Moon and the claimed invention. However, whether or not Applicants' disclosure or Moon discloses a functional significance to the structural differences between the claimed LCD and the LCD of Moon is not germane to the patentably of the claimed invention. Independent claim 15 defines an apparatus comprising a specified structure. Therefore, the patentably of claim 15 rests on the claimed structure, not the functionality achieved by said structure.

As acknowledged by the Examiner, Moon fails to disclose an LCD device which includes each and every claimed element. Accordingly, absent proper motivation to alter the structure of Moon, the rejection of claims 15-22 is improper.

The Examiner also asserts that in considering the disclosure of a reference it is proper to take into account not only specific teachings of the reference but also that inferences which one skilled in the art would reasonably be expected to draw there from. However, the Examiner fails to provide any evidence as to why one skilled in the art would have inferred the structure of the claimed invention from the teachings of Moon. More specifically, the Examiner fails to provide any evidence as to why one skilled in the art would have inferred from Moon's disclosure of forming a gate insulating layer 5 over the gate electrode 3 that the gate insulating layer 5 should

be formed on an the entire surface of the substrate except an upper portion of the storage capacitor electrode as recited in claim 15.

Finally, the Examiner asserts that only removal of the first insulating layer from above the capacitor electrode is required to achieve the claimed invention, therefore alternate species wherein the insulating layer is retained or eliminated from other regions are considered clearly unpatentable. To support this assertion the Examiner points to §808.01(a) the MPEP which states that election of species should not be required if the species claimed are considered clearly unpatentable over each other. It is unclear to Applicants why the Examiner is citing restriction practice in support of a rejection under 35 U.S.C. §103, nevertheless the Examiner's assertions are unfounded.

The Examiner appears to be asserting that if the present invention claimed the subject matter of Moon, there wouldn't be a restriction requirement. However, contrary to his assertion the Examiner withdraws claims 1 and 3-5 from consideration because they are drawn to a patently distinct species IB. Accordingly, the Examiner contradicts himself by asserting that claim 1 and 15 are patentably distinct because of their structural differences, while asserting claim 15 and the device of Moon are not patentably distinct because they achieve the same function despite their structural differences.

Accordingly, should the Examiner maintain this rejection is a future Action, Applicant requests that the Examiner withdrawal his restriction of claims 1 and 3-5.

Claims 16-22 variously depend from independent claim 15. Therefore, claims 16-22 are patentably distinguishable over Moon for at least those reasons presented above with respect to claim 15. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 15-22 under 35 U.S.C. §103.

In paragraph 5 of the Office Action, the Examiner rejects claims 23-25 under 36 U.S.C. §103(a) as allegedly being unpatentable over Moon in view of U.S. Patent No. 6,545,730 to Hwang ("Hwang"). Applicants respectfully traverse this rejection.

Claim 23-25 variously depend from independent claim 15. Therefore, claims 23-25 are patentably distinguishable over Moon for at least those reasons present above with respect to claim 15. Hwang discloses a thin film transistor array panel for a liquid crystal display, however, Hwang fails to overcome the deficiencies of Moon.

Since Moon and Hwang both fail to disclose or suggest an LCD device that includes a first insulating layer formed on an entire surface of the first substrate except an upper portion of the storage capacitor electrode, the combination of these two references cannot possibly disclose or suggest said feature. Therefore, even if one skilled in the art were motivated to combine Moon and Hwang, the combination would still fail to render claims 23-25 unpatentable for at least the reason that the combination fails to disclose each and every claimed element. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 23-25 under 35 U.S.C. §103.

The application is in condition for allowance. Notice of same is earnestly solicited. Should the Examiner find the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the

filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

Dated: January 13, 2005

Respectfully submitted,

By _____
Rebecca Goldman Rudich
Registration No.: 41,786
MCKENNA LONG & ALDRIDGE LLP
1900 K Street, N.W.
Washington, DC 20006
(202) 496-7500
Attorney for Applicant